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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/810,629	03/16/2001	Dan Edward Curtis	RSW920010035US1	7357

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EXAMINER
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REAGAN, JAMES A

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 03/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/810,629

Applicant(s)

CURTIS ET AL.

Examiner

James A. Reagan

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### **Status of Claims**

1. This action is in response to the amendment filed on 19 November 2004.
2. Claims 31-42 have been added.
3. Claims 1-42 have been examined.

## **RESPONSE TO ARGUMENTS**

4. Applicant's arguments received on have been fully considered but they are not persuasive. Referring to the previous Office action, Examiner has cited relevant portions of the references as a means to illustrate the systems as taught by the prior art. As a means of providing further clarification as to what is taught by the references used in the first Office action, Examiner has expanded the teachings for comprehensibility while maintaining the same grounds of rejection of the claims, except as noted above in the section labeled "Status of Claims." This information is intended to assist in illuminating the teachings of the references while providing evidence that establishes further support for the rejections of the claims.

With regard to the limitations of claims 1, 7, 11, 15, 19, 23, and 25, Applicant argues that Gershman does not teach or suggest the first, second, third, or fourth features as described in the remarks beginning on page 12 of the response. The Examiner respectfully disagrees. The rejections, as shown below, plainly describe the features of the claimed invention. It appears as if the Appellant is attacking the references in a piecewise fashion, instead of in combination, as intended by the Examiner and as shown above in the rejections under 35 USC § 103(a). The combination of Gershman/Brockman, clearly disclose the gathering information, analyzing it, generating reports, and providing the reports to clients. Obviously, the first three steps are intrinsic to the reporting process, and must be completed before any form of report may be

issued. Since Gershman discloses an extensive product review beginning in column 34, it is self-evident that the review of the product must be related to and applicable to the product itself. Using the same steps as disclosed by Gershman, one of ordinary skill in the art could easily modify the Gershman invention to adequately and completely disclose the instant invention. In this case, characteristics, performance, security and availability of an ISP/ASP would be appropriate descriptors of the product/service, as is the framework described by Gershman. Consequently, Applicant's attempt to distinguish between a product and service is unconvincing. In the case of an ISP/ASP, the product is also a service, and vice versa, as one of ordinary skill in the art would undoubtedly understand and concur with. Moreover, that a prior art reference is reasonably pertinent to the particular problem with which the applicant was concerned, and is therefore relied upon as a basis for rejection of the claimed invention.

#### **Claim Rejections - 35 USC § 103**

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gershman and further in view of Brockman et al, (US 2002/0123919 A1).

**Examiner's Note:** The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

**Claims 1, 4 7, 11, 15, 19, 23, and 27:**

Gershman discloses a method for characterizing a service provider (Abstract, Fig 1A, 16, associated text; C34, L8-42), essentially disclosing:

- gathering information on characteristics of a service provider;
- analyzing the information to provide an outcome;
- generating a report responsive to the outcome; and
- providing the report to at least two clients of the service provider;
- wherein the acts of analyzing, generating, and providing are performed by a
- management service.

Gershman does not specifically disclose that the service providers are ASPS and/or ISPS. However, Gershman does teach that all types of vendors/suppliers/service providers may be targets for analysis reports (Fig 1A). Moreover, Brockman discloses a management service method and system that targets a telecommunications service provider (Abstract; Summary of the Invention). ASPS and ISPS are vendors playing major roles in business applications and telecommunications. Therefore, it would have been obvious for one ordinarily skilled in the art at the time the invention was made to have adapted Gershman's system to many different types of providers, including telecommunications vendors such as ISPS, as taught by Brockman, and/or to

ASPS, because the system can easily be adapted to any type of provider, and as such, would increase the revenue stream for the management service. In addition, Gershman teaches that "availability" of products/services is a significant characteristic for customers to learn about and make decisions on (Summary of the Invention; Fig 10A, associated text; C2, L65). Brockman, erstwhile, discloses that "performance" is yet another yardstick by which clients should measure their intended or current vendors (Par. 17, 66-67, 106-109). Other significant characteristics such as price, customer service, and others may be used in the analyses and reports, as taught by both references. Therefore it would have been obvious to one ordinarily skilled in the art at the time the invention was made to have included "performance", "availability", and "security" the main characteristics to analyze and report on, in the case of ASPS and ISPS, because those are by far the most important features distinguishing one vendor from another in this field.

**Claim 4:**

Gershman discloses all the limitations of claim 1. Neither Gershman nor Brockman specifically disclose the act of providing comprises the act of selling the report. Gershman's system however, is directed toward consumers and Brockman's to businesses. Therefore, it's obvious that both systems are designed to offer services for payment from their target audiences. It would have been obvious to one ordinarily skilled in the art at the time the invention was made that management reports such as those contemplated by both references would not be offered free of charge.

**Claims 5 and 6:**

Gershman discloses all the limitations of claim 1. Gershman further teaches that his reports will be available to clients online (Fig 16, associated text) as well as in hard copy (C46, L64).

**Claims 8, 12, 16, 20, 24, and 28:**

Gershman in view of Brockman discloses all the limitations of claims 7, 11, 15, 19, 23, and 27, respectively. Using the same analysis as for claim 4 above, Gershman and Brockman further disclose: the act of providing composes the act of selling the report.

**Claims 9, 13, 17, 21, 25 and 29:**

Gershman in view of Brockman discloses all the limitations of claims 7, 11, 15, 19, 23, and 27, respectively. Gershman further discloses the report comprises hard copy (see claim 5 above).

**Claims 10, 14, 18, 22, 26, and 30:**

Gershman in view of Brockman discloses all the limitations of claims 7, 11, 15, 19, 23, and 27, respectively. Gershman further discloses: the report comprises soft copy (see claim 6 above).

**Claims 31-42:**

The combination of Gershman/Brockman discloses the limitations as shown above. Gershman/Brockman do not expressly show:

- the information on the performance of the application service provider includes information about responsiveness of the application service provider;
- the information about the responsiveness of the application service provider is characterized statistically by a mean value and a probability density function or cumulative distribution function that describe a time between receipt by the application service provider of an incoming request to the application service provider and an outgoing response from the application service provider;

- the information on security concerns a vulnerability of the service provider to attacks by unauthorized parties seeking to steal information from the service provider or to vandalize the service provider;
- the information on security is characterized statistically by a count or other measure of said attacks that result in adverse consequences to the serviced provider or in adverse consequences to one or more clients or in adverse consequences to a member of a user population over a given period of time;
- the information on availability of the application service provider concerns a susceptibility of the service provider to failure;
- said feature is measured by minutes-of-time-per-month when the service provider is unable to respond within a predetermined interval to an incoming request from a client or from a member of a user population;

However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The information collection and storage steps would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to collect from a service provider any type of security information, performance information, and statistical analysis thereof, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.



**Conclusion**

7. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
8. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **James A. Reagan** whose telephone number is **(703) 306-9131**. The examiner can normally be reached on Monday-Friday, 9:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **James Trammell** can be reached at (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **(703) 305-3900**. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> . Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks**

**Washington, D.C. 20231**

or faxed to:

**(703) 305-7687** [Official communications; including

After Final communications labeled "Box AF"]

**(703) 308-1396** [Informal/Draft communications, labeled "PROPOSED"

or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7<sup>th</sup> floor receptionist.

JAR

07 March 2005

